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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,752	03/10/2000	David P. Andrew	1855.1064-003	4925
21005	7590	05/28/2004	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133			NOLAN, PATRICK J	
			ART UNIT	PAPER NUMBER
			1644	

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,752

Applicant(s)

ANDREW ET AL.

Examiner

Patrick J. Nolan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46, 148-201, 217-232 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15, 146, 148, 153-171, 219, 220, 222 and 223 is/are allowed.
- 6) ☒ Claim(s) 151, 152, 172-183, 185-193, 195-201, 217, 218, 221 and 224-232 is/are rejected.
- 7) ☒ Claim(s) 184 and 194 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 146, 148-201 and 217-232 are pending and are under consideration in the instant application.

Claim Rejections - 35 USC § 112 first paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 182-183, 185-193, 195-201, 217-218 and 229-232 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention, for reasons of record set forth in the Paper mailed 9-9-2003.

Applicant's arguments filed 3-8-2004 have been fully considered but are not found persuasive.

Applicant argues they have amended the claim in concert with the Examiner's suggestions by inserting the claim recitation that the antibody inhibits binding of TECK to a GPR-9-6.

However, the rejection was based in part upon the recitation of 90% similarity language. Applicant's do not have sufficient written description for the genus of antibodies that inhibit binding of TECK to a GPR-9-6 that has at least about 90% sequence similarity to the amino acid sequence of SEQ ID NO. 2.

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Claim Rejections – 35 U.S.C. §§ 102 and 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 151-152, 172-180, 192-200, 221 and 224-226 stand rejected under 35 U.S.C. 102(a) as being anticipated by Zabel et al. (J. Exp. Med. 1999; 190(9):1241-1255, IDS #AR3, see entire document), of record, for reasons of record set forth in the Paper mailed 9-9-2003.

4. Claims 151-152, 172-181, 192-201, 221 and 224-226 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Zaballos et al. (J. Immunol. 1999; 162:5671-55675, IDS #AX2) in view of Chuntharapai et al. (Methods in Enzymology 1997; 288:15-27, IDS #AY2), both of record, for reasons set forth in the Paper mailed 9-9-2003.

5. Claims 227-228 and 231-232 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Zaballos et al. (J. Immunol. 1999; 162:5671-55675, IDS #AX2) in view of Chuntharapai et al. (Methods in Enzymology 1997; 288:15-27, IDS #AY2) as applied to claims 151-152, 172-181, 192-201, 221 and 224-226 above, and further in view of Chuntharapai et al. (US Pat. No. 5,440,021), all of record, for reasons set forth in the Paper mailed 9-9-2003.

6. Claims 181, 201, 227-228 and 231-232 stand rejected under 35 U.S.C. 103(a) unpatentable over Zabel et al. (J. Exp. Med. 1999; 190(9):1241-1255, IDS #AR3) in view of Chuntharapai et al. (US Pat. No. 5,440,021), all of record, for reasons set forth in the Paper mailed 9-9-2003.

Applicant's arguments filed 5-25-04 have been fully considered but are not found persuasive.

Applicant argues the submission of a 35 USC 1.131 declaration obviates all the rejections. The declaration has not been considered since it has not been properly executed.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is 571-272-0847.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at 571-272-0841.



Patrick J. Nolan, Ph.D.

Primary Examiner, Group 1640

May 25, 2004